

ATTORNEY DOCKET NO. 05015.0365U1
APP. SERIAL NO. 09/662,965

REMARKS

The Office Action has rejected claims 1-5, 7, 9, 22 and 24-28. Claims 1 and 22 have been canceled and new claims 29 and 30 have been added herewith as further described below.¹

As an initial matter, Applicants wish to thank Examiner Short for the courtesies extended in the telephone interview of July 28, 2003 with Applicants' representative Jacqueline Hutter. As discussed in that interview, Applicants have added new claims 29 and 30 to recite the transitional phrase "consisting essentially of" in relation to the biodegradable polymer aspect of these claims. Claims 2-5, 7, 9, and 24-28 have been amended to conform these claims to claims 29 and 30. The remaining pending claims have been amended to correct claim dependency. Each of these amendments is made without prejudice. Additionally, Applicants are herewith submitting a Declaration under 37 C.F.R. 1.132 to demonstrate the patentability the claims over the Blumenthal *et al.* reference. As discussed in the July 28, 2003 telephone interview, Applicants believe the claims are now in condition for allowance.

I. Rejection in Light of Blumenthal

The Office Action has rejected claims 1-5, 7, 9-11, 14-15, 17-18, 21-22 and 24-28² under 35 U.S.C. § 102(b) as being anticipated or obvious over Blumenthal *et al.* (U.S. Patent No. 5,750,605). In particular, the Office Action asserts that the aliphatic-aromatic copolyester "encompasses the sulfonated polyester of that reference."

Claims 29 and 30 have been added herewith to specifically recite the transitional phrase "consisting essentially of." As such, the present claims necessarily exclude materials that would change the basic and novel characteristics of the invention.

The reference at issue, Blumenthal *et al.*, discloses polyester materials having sulfonated groups. As disclosed therein and as explained in the Irick, Jr. Declaration submitted herewith, such groups make the polyesters of Blumenthal *et al.* sensitive to water. In particular,

¹ The substance of the claims herewith are identical to the claims submitted with the non-compliant amendment submitted August 20, 2003 except that claims 1 and 23 submitted therewith have been rewritten as new claims 29 and 30, respectively. The dependencies of the remaining claims have been rewritten accordingly.

² In the Amendment dated February 21, 2003, Applicants deleted claims 10-11, 14-15, 17-18 and 21, without prejudice. Thus, it appears that the Office Action inadvertently included these canceled claims in the present rejection.

ATTORNEY DOCKET NO. 05015.0365U1
APP. SERIAL NO. 09/662,965

Blumenthal *et al.* states that water solubility or sensitivity of the hot melt materials therein results from the presence of sulfonated groups. (col. 5, line 21). Moreover, Blumenthal indicates that such water solubility or sensitivity is a desired feature of the hot melt materials of that invention. In particular, Blumenthal states “[f]or various applications, it is also desired that some hot melt adhesives be hydrophilic, i.e., be water-soluble, water-sensitive or water activated” (col. 1, line 42). It also states that “[t]he present invention stems from the growing need for hydrophilic materials....” Thus, Blumenthal *et al.* is directed toward a water soluble or water sensitive hot melt material and such properties are conferred by the presence of sulfonated groups in the compositions therein.

Claim 29 of the present invention recites methods of making an article from the specified composition, where the article comprises a film, a bottle, a blow molded article, an injection molded article or a container. Further, claim 30 of the present invention recites a composition suitable for preparing an article where the article is a film, a bottle, a blow molded article, an injection molded article or a container. As set forth in the Irick, Jr. Declaration, it would be disadvantageous to such articles for them to be either water soluble or swellable by water. Therefore, the presence of sulfonated groups in the aliphatic-aromatic copolymers of the present invention would change the basic and novel characteristics of the present invention and, as such, are necessarily excluded from the claims as amended. Accordingly, it is respectfully submitted that the claims, as amended herewith, are allowable over the Blumenthal *et al.* reference.

II. Rejection in light of Schoenberg, Rutherford, Iovine or Kaufman and Japanese '903.

The Office Action has rejected claims 1-5, 9-11, 14-15, 17-18, 21-22 and 25-28 under 35 U.S.C. § 102(b) or, alternatively, as obvious in view of Schoenberg, Rutherford, Iovine or Kaufman as was asserted in a prior Office Action. The Office Action further rejected claims 1-5, 9-11, 14-15, 17-18 21-22 and 24-28 under 35 U.S.C. § 102(b) or, alternatively, as obvious in view of Japanese '903. Applicants have added claims 29 and 30 herewith to delete reference to the aliphatic polyester and cellulose ester components previously recited in these claims. As discussed in the telephone interview of July 28, 2003, amendment of

ATTORNEY DOCKET NO. 05015.0365U1
APP. SERIAL NO. 09/662,965

the claims to delete these previously claimed aspects is believed to make the present claims allowable over each of these references.

In light of the above Amendment and Remarks, Applicants respectfully request that the rejections be withdrawn.

No additional fee is believed due; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION UNDER 37 C.F.R. § 1.8

I hereby certify that this PRELIMINARY AMENDMENT is being sent via facsimile transmission addressed to (703) 872-9311 ATTN: EXAMINER P. SHORT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Jacqueline M. Hutter
Jacqueline M. Hutter

Date

9/10/03